(14,180.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1893.

No. 200.

ANDREW L. SMITH AND HENRY BRANDELL, APPELLANTS,

vs.

JOHN PIRKL.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE EASTERN DISTRICT OF NEW YORK.

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JUDD & DETWEILER, PRINTERS, WASHINGTON, D. C., OCTOBER 27, 1893.

1 The President of the United States of America to Andrew L. Smith and Henry Brandall, Greeting:

You are hereby commanded that you and each of you personally appear before the judge of the circuit court of the United States of America for the eastern district of New York, in equity, on the first Monday in August, A. D. 1889, whereso-ver the court shall then be, to answer a bill of complaint exhibited against you in said court by John Pirkl, and to do further and receive what the said court shall consider in that behalf; and this you are not to omit under the penalty on you and each of you of two hundred and fifty dollars.

Witness the Hon. Morrison R. Waite, Chief Justice of the Supreme Court of the United States, at the city of Brooklyn,
2 on the 9th day of July, in the year of our Lord one thousand eight hundred and eighty-nine.

B. LINCOLN BENEDICT, *Clerk.*

W. M. K. OLCOTT,
Complainant's Solicitor, 156 B'way, N. Y. City.

The defendants are required to enter appearance in the above cause in the clerk's office of the court on or before the first Monday of August, 1889, or the bill will be taken "*pro confesso*" against them.

B. LINCOLN BENEDICT, *Clerk.*

W. M. K. OLCOTT,
Complainant's Solicitor.

The within *subpœna ad respondendum* was personally served on Andrew L. Smith and Henry Brandall on the 10th day of July, 1889, in the city of Brooklyn, by delivering to and leaving
3 with each of them a copy thereof, and at the same time and place exhibited to them the within original.

Dated August 5th, 1889.

CHARLES M. STAFFORD,
U. S. Marshal.
JAMES BIGGART, *Deputy.*

Endorse: *Subpœna ad respondendum.* Filed August 5, 1889.

4 U. S. Circuit Court for the Eastern District of New York.

To the honorable the judges of the circuit court of the United States for the eastern district of New York:

John Pirkl, of the city of Brooklyn, county of Kings and State of New York, and a citizen of State — New York, brings this his bill of complaint against Andrew L. Smith and Henry Brandell, each of whom is of the city of Brooklyn, county of Kings, and a citizen of said State of New York, as your orator is informed and believes, and both of whom are doing business under the firm name

or style of Smith & Brandell at No. 90 Pearl street in said city of Brooklyn, as manufacturers of iron window guards, railings, gates, &c.

And thereupon your orator complains and says: That heretofore, and prior to the first day of May, 1888, by his own industry, genius, efforts and expenses, he invented and produced, and was the original and first inventor of a certain new and useful design for a window guard, as fully described in the letters patent hereinafter mentioned, and which had not been known nor used before
5 his said invention, and which at the time of his application for a patent, as hereinafter mentioned, had not been for more than two years in public use or on sale with his consent or allowance, or otherwise.

And your orator further shows unto your honors, that, being so as aforesaid the first inventor and producer of said design, and being also a citizen of the United States, he did on the said first day of May, 1888, upon due application therefor, obtain design letters patent of the United States for said invention in due form of law, under the seal of the Patent Office of the United States, signed by the Assistant Secretary of the Interior, and countersigned by the Commissioner of Patents of the United States, bearing date the day and year last aforesaid and numbered design No. 18293, whereby there was granted and secured to your orator aforesaid, his heirs, administrators and assigns, for the term of seven years from and after the date of said design letters patent, the full and exclusive right and liberty of making, constructing, using and vending to others to be used, the said invention and improvements, as set forth in said design letters patent.

And your orator further shows unto your honors, that he is the sole and exclusive owner of said design letters patent, and the invention and improvements described therein, and of all the rights and privileges granted and secured or intended to be granted and secured thereby.

And that he has invested and expended large sums of money, and has in many ways been to great trouble in and about said invention, and for the purpose of carrying on the business of producing ornamental gates and window guards embodying said invention by him patented as aforesaid, and making the same profitable to himself and useful to the public, and that said invention has been and is of great benefit and advantage, and that large numbers of gates and window guards, embodying said invention, were made according to said invention and sold by him and those in
6 privity with him, to the great advantage of the public, and that the public have generally acknowledged and acquiesced in the aforesaid rights of your orator, and your orator believes that he will realize and receive large gains and profits therefrom if infringements by said defendants and their confederates shall be prevented.

Yet the said defendants, well knowing the rights and premises secured to your orator aforesaid, but contriving to injure your orator and to deprive him of the benefits and advantages which might and

otherwise would accrue unto him from said invention, heretofore and after the issuing of said letters patent as aforesaid, and before the commencement of this suit, did, as your orator is credibly informed and believes, at said city of Brooklyn and in the city of New York, in said eastern and in the southern district of New York respectively, without the license or allowance and against the will of your orator, and in violation of his lawful rights, and in infringement of the aforesaid lawful letters patent granted as aforesaid, knowingly, unlawfully and wrongfully, and in defiance of the rights of your orator, make, construct, use and vend to others to be used, a gate or gates, or a window guard or window guards, made according to and employing and containing said invention, and that they still continue so to do, and that they are now threatening to sell the aforesaid gates or window guards, infringing said patent in large quantities, and to supply the market therewith and to sell the same—

All in defiance of the rights acquired and secured to your orator as aforesaid, and to his very great and irreparable loss and injury, and by which your orator has been and still is being deprived of great gains and profits which he might and otherwise would have obtained, but which have been received and enjoyed and are being received and enjoyed by the said defendants by and through their aforesaid acts and doings.

7 And your orator further shows unto your honors, on information and belief, that said defendants have heretofore sold large quantities of said gates or window guards, and have a quantity on hand which they are about to offer for sale, and have made and received large profits and advantages therefrom, but to what extent and how much exactly your orator at this time does not know, and prays a discovery thereof. And your orator further says that the use of the said invention by said defendants, and their preparation for and determination to continue the same, and their other aforesaid unlawful acts in disregard and defiance of the rights of your orator, have the effect to and do encourage and induce others to venture to infringe said patent in disregard of your orator's rights.

And forasmuch as your orator can have no adequate relief except in this court, to the end, therefore, that the said defendants and each of them may, if they can, show why your orator should not have the relief hereby prayed, and may, upon their oath and according to their best and utmost knowledge, remembrance, information and belief, full, true, direct and perfect answers make to the premises and to all the several matters hereinbefore stated and charged, as fully and particularly as if separately interrogated as to each and every of said matters, and may be compelled to account for and pay over to your orator the profits by them acquired and the damage suffered by your orator from the said unlawful acts.

And that the said defendants and each of them be directed and compelled to pay over to your orator the sum of two hundred and fifty dollars ($250.00), and in case the total profit made by them from the manufacture or sale, as aforesaid, of the article or articles to which the design or colorable imitation has been applied exceeds

the sum of two hundred and fifty dollars, that the said defendants and each of them be directed and compelled to pay over to
8 your orator, in addition to the said sum of two hundred and fifty dollars ($250.00), all profits made by them in excess of said sum.

And may it please your honors, the premises considered, to grant unto your orator a writ of injunction, issued out of and under the seal of this honorable court, or issued by one of your honors according to the form of the statute in such case made and provided, perpetually enjoining and restraining said defendants, or either of them, or their said firm, their clerks, attorneys, agents, servants and workmen from directly or indirectly making, constructing, using, vending, delivering, working or putting into practice, operation or use, or in anywise counterfeiting or imitating the said invention or any part thereof, or any "design for a window guard," or any gate or window guard made in accordance therewith, or like or similar to those which he has aforesaid made, and that said defendants may be decreed to pay the costs of this suit, and that your orator may have such further relief or such other relief as to this honorable court shall seem meet and as shall be agreeable to equity. And may it please your honors to grant unto your orator a provisionary or preliminary injunction, issued out of and under the seal of this honorable court, enjoining and restraining the defendants, and either of them, and their said firm, their or its attorneys, clerks, agents, servants and workmen to the same purport, tenor and effect hereinbefore prayed for in regard to said perpetual injunction.

May it please your honors to grant unto your orator a writ of subpœna of the United States of America, issuing out of and under the seal of this honorable court, directed to said Andrew L. Smith and said Henry Brandell, defendants, commanding them and each of them, on a day certain therein to be named, and under a certain penalty, to be and appear in this honorable court, then and there to answer all and singular the premises, and to stand
9 to, perform and abide such further order, direction and decree as may be made against him.

And your orator will ever pray, &c.

JOHN PIRKL,
Complainant.

W. M. K. OLCOTT,
Solicitor and of Counsel for Complainant,
No. 156 *Broadway, New York City.*

CITY AND COUNTY OF NEW YORK, *ss:*

John Pirkl, being duly sworn, deposes and says: That he is the complainant in the foregoing bill named, and has read the foregoing bill of complaint, and knows the contents thereof; and that the same is true of his own knowledge, except as to the matters therein stated to be alleged on information and belief, and that as to those matters he believes it to be true. And further, that he believes himself to be the original, first and sole inventor of the in-

vention described and claimed in the design letters patent mentioned in said bill.

JOHN PIRKL.

Sworn to before me this 24th day of June, 1889.

JOHN C. RHODES,
[SEAL.] *Notary Public, Kings County.*

Certificate filed in N. Y. county.

Endorsed: Bill of complaint. Filed July 9, 1889.

10 U. S. Circuit Court, Eastern District of New York.

JOHN PIRKL
vs.
ANDREW L. SMITH and HENRY BRANDALL.

To the clerk of said court:

Please take notice that I am retained by Andrew L. Smith and Henry Brandall, the defendants herein, and appear for them in this action, and you are requested to enter said appearance.

Dated July 31, 1889.

Yours, &c.,

NOAH TEBBETTS,
Solicitor for Andrew L. Smith and Henry Brandall, Defendants.

Endorsed: Notice of appearance. Filed August 1, 1889.

11 Circuit Court of the United States for the Eastern District of New York.

JOHN PIRKL
vs.
ANDREW L. SMITH and HENRY BRANDELL.

The joint and several answer of Andrew L. Smith and Henry Brandell, defendants, to the bill of complaint of John Pirkl, complainant.

The defendants, now and at all times hereafter saving and reserving to themselves all, and all manner of benefit and advantage of exception that can or may be taken or had to the manifold errors, imperfections, and insufficiencies in the said bill of complaint contained, for answer thereunto or unto such parts thereof as they are advised it is material or necessary for them to make answer unto, answering, say:

That they do not know, and are not informed save by said bill, whether or not the said complainant is a citizen of the United States, or resides in the city of Brooklyn, in said district, and they
12 leave the complainant to make such proof thereof as he may be advised is material.

The defendants admit that they are citizens of the State of New York, and are doing business at No. 90 Pearl street, in said city of Brooklyn, as manufacturers of steam wire and iron railing, gates, &c.

The defendants further answering say they do not know and are not informed, save by said bill, whether or not the said complainant heretofore and prior to May 1, 1888, by his own industry, genius, efforts and expense, invented and produced, and was the original and first inventor of a certain design for a window guard, described in said bill of complaint, or whether the same had not been known or used before his invention—or whether the same at the time of his application for said patent had not been for more than two years in public use or on sale with his consent or allowance or otherwise, or that letters patent for said invention were granted and issued to said complainant, or that the said complainant is the sole and exclusive owner of said design letters patent and the inventions and improvements described therein as alleged in said complaint, and therefore leave the complainant to make such proof thereof as he may be advised tobe necessary and material.

And the defendants, further answering, say that they have no knowledge save by said bill, that the complainant has invested and expended large sums of money, and been to great trouble and expense in and about said invention and for the purpose of carrying on the business of producing gates and window guards, embodying said invention, or that said invention has been and is of great benefit and advantage and that large numbers of gates and window guards, embodying said invention, have been made and sold by complainant and those in privity with him, and that the complainant will realize large gains and profits thereform as alleged
13 in said bill of complaint, and thereupon defendants leave the complainant to make such proof thereof as he may be advised is material.

And the defendants further answering, deny that since the issuing of the said design letters patent, and without the license or allowance of the complainant, that they have knowingly, unlawfully and wrongfully made, constructed, used and vended to others to be used, a gate or gates, or a window guard or window guards, made according to and embodying and containing said invention, and they also deny they are now threatening to sell such gates or window guards in large quantities or in any quantity whatever, or to supply the market therewith and to sell the same, or that they have received or are receiving any gains and profits therefrom.

And the defendants further answering, deny that they have heretofore sold large quantities of said gates or window guards, and that they have a quantity of them on hand which they are about to offer for sale.

And the defendants further answering, deny that they have made any preparation to use the said invention of the complainant, or that any act of these defendants or either of them has been or is in defiance of said design letters patent, or of any right alleged to be acquired by or secured to the complainant, or has been to the

great, irreparable, or any loss or injury of the complainant, or that the complainant has by any act of the defendants or either of them, been or still is being deprived of alleged great or any gains or profits that might or otherwise would have been obtained, or which might have been realized or enjoyed by or through any act or doing of these defendants or either of them.

And these defendants further answering, aver that in the month of March, 1888, and before the granting and issuing of said design letters patent to the complainant, they received any order from the firm of Squire & Whipple, in the city of New York, for certain iron-work which included window guards similar in design
14 to that described in the said design letters patent, and that the defendants did thereupon make such window guards and furnish and deliver the same to said Squire & Whipple, the value of said guards being about the sum of two hundred dollars.

That after defendants had received and accepted said order, the said complainant came to the defendants' place of business in the said city of Brooklyn and saw Andrew L. Smith, one of these defendants, and told him that he, the complainant, understood that the defendants had obtained said order from said Squire & Whipple for said window guards, and that said Squire & Whipple were old customers of his, and he, the complainant, was sorry to lose their custom. Said complainant told said Smith that he had also bid for the same work for Squire & Whipple, and that the defendants' bid was the lowest, and the said complainant did not make known to said defendant, Andrew L. Smith, or to either of said defendants, that he had a design letters patent for such window guards, and that he had applied for such letters patent, but, on the contrary, concealed the existence of said letters patent or his application for the same, from the said defendants, and either of them and allowed and permitted the defendants to *to* go on and make and furnish, and deliver the said window guards, and incur expense therefor which they would not have done, or incurred, if complainant had told them, or either of them, that he had said letters patent or had applied for the same.

The defendants, further answering, say, that at the time of the making, selling and delivering by them of said window guards, as aforesaid, these defendants, and each of them, were wholly ignorant and had no knowledge whatever that letters patent covering the said window guards had been granted or issued to the complainant, and that the said window guards, made and sold as aforesaid, were all the window guards of a design similar to that claimed by the complainant which the defendants, or either of
15 them, have made or sold, and that the defendant, Andrew L. Smith, has examined window guards of similar design and pattern to those sold by said defendants to said Squire & Whipple, which were made, as defendants are informed and believe, by the complainant prior to the receiving by defendants of the said order from said Squire & Whipple, and which were put up by said complainant on the buildings on the north side of One hundred and twentieth street and Mount Morris park, near Sixth avenue,

New York city. And that there are no marks or stamps of any kind or description thereon, to indicate, denote or show that letters patent had been granted therefor, or that the same had been applied for. And that the defendants had no knowledge or information whatever that design letters patent had been granted or issued to the complainant, as alleged in said bill of complaint, until long after the defendants had delivered said window guards to said Squire & Whipple as aforesaid.

And these defendants pray the same benefit of the facts and things herein set forth as if for the reason thereof the said bill had been demurred to, where a demurrer would have been proper, and the same benefit thereof as if the defendants had specially pleaded to said bill, where a special plea would have been proper.

And these defendants submit to this honorable court that said complainant is not entitled to any further or other answer to said bill than is hereinbefore contained, and has no right to any injunction or restraining order, account, damages, or other relief prayed for in said bill.

And these defendants pray to be hence dismissed with their reasonable costs and charges in this behalf most wrongfully sustained.

ANDREW L. SMITH.
HENRY BRANDELL.

NOAH TEBBITTS,
Solicitor for Defendants.

16 UNITED STATES OF AMERICA, } ss:
Eastern District of New York, County of Kings, }

On this 29th day of August, 1889, before me personally appeared Andrew L. Smith and Henry Brandell, who being by me severally sworn, each for himself, deposes and says: That he is one of the defendants in this suit, that he has read the foregoing answer subscribed by him, and knows the contents thereof, and that the same is true to his own knowledge except as to the matters therein stated to be alleged upon information and belief, and as to those matters he believes it to be true.

WILLIAM M. BENEDICT,
[SEAL.] *Notary Public, Kings County, N. Y.*

Endorsed: Answer. Filed August 30, 1889.

United States Circuit Court, Eastern District of New York.

JOHN PIRKL
against } In Equity.
ANDREW L. SMITH and HENRY BRANDELL.

The Replication of John Pirkl, the Above-named Complainant, to the Answer of Andrew L. Smith and Henry Brandell, Defendants.

This repliant, saving and reserving to himself now and at all times hereafter all and all manner of benefits and advantage of ex-

ception which may be had and taken to the manifold insufficiencies of the said answer, for replication thereto says that he will aver, maintain and prove his bill of complaint to be true, certain and sufficient in the law to be answered unto; and that said answer of said defendants is uncertain, untrue and insufficient to be
17 replied unto by repliant; without this, that any other matter or thing whatsoever, in the said answer contained, material or effectual in the law to be replied unto, and not herein and hereby well and sufficiently replied unto, confessed and avoided, traversed or denied, is true; all which matter- and things the repliant is and will be ready to aver, maintain and prove as this honorable court shall direct, and humbly prays as in and by his said bill he hath already prayed.

W. M. K. OLCOTT,
Solicitor for Complainant, 156 Broadway, N. Y.

Endorsed: Replication. Filed Sept. 25, 1889.

U. S. Circuit Court, Eastern District of New York.

JOHN PIRKL
vs.
ANDREW SMITH *et al.*

I hereby consent that Leavitt & Keith be substituted as solicitors for defendants in my place and stead.
Dated Oct. 19, 1889.

NOAH TEBBETTS,
Defendants' Solicitor.

Endorsed: Consent of substitution. Filed March 3, 1890.

18 At a stated term of the circuit court of the United States of America, for the eastern district of New York, in the second judicial circuit, held at the United States court-rooms, in the city of Brooklyn, on the 3rd day of March, in the year of our Lord one thousand eight hundred and ninety.

Present: The Honorable Charles L. Benedict, district judge, holding the court.

JOHN PIRKL
vs.
ANDREW L. SMITH *et al.*

On the consent of Noah Tebbetts, Esq., solicitor for defendants, and on motion of Leavitt & Keith—

It is ordered that Leavitt & Keith be, and the same are hereby, substituted in place and stead of Noah Tebbetts as solicitor for the defendants in the above-entitled action.

CHARLES L. BENEDICT.

Endorsed: Order for substitution. Filed March 3, 1890.

19 At a stated term of the circuit court of the United States of America for the second judicial circuit, held at the United States court-rooms, in the city of Brooklyn, on the 1st day of April, in the year of our Lord one thousand eight hundred and ninety.

Present: Hon. Hoyt H. Wheeler, district judge, holding court by assignment.

JOHN PIRKL
vs.
ANDREW L. SMITH *et al.*

Final Hearing.

Appearances: Mr. Olcott, for complainant; Mr. Keith, for defendant-.

Mr. Olcott reads the direct examination of JOHN PIRKL, a witness called for the complainant, as follows:

20 1 Q. What is your age, residence and occupation?

A. Age, 46; occupation, iron railing and window guards; residence, 149 Driggs street, Brooklyn.

2 Q. And your place of business is also there?

A. Yes, sir.

3 Q. Look at the paper now handed to you and state what it is.

A. This is the patent that was granted to me for the window guards.

4 Q. It is the patent referred to in your complaint in this action?

A. Yes, sir.

5 Q. Is that patent now your property?

A. Yes, sir.

6 Q. You have made no assignment to any one?

A. No, sir.

The patent shown witness is offered in evidence, and marked Complainant's Exhibit A.

Defendants' counsel objects to the offer of the letters patent in evidence, unless it be proved that the infringement occurred subsequent to the granting of the letters patent.

(It is stipulated that Patent Office copies of letters patent, of applications or any other papers on file in the Patent Office, may be used in place of the originals by either side.)

7 Q. Mr. Pirkl, when did you apply for these letters patent?

Objected to.

A. It was—I can't say now, or anyhow from three to four months before the patent was granted.

8 Q. So that you are certain that it was before that date?

Objected to.

A. It was somewheres around in January when I applied for it.

9 Q. Who originated the design which is the subject of this patent?

A. It was myself originated it.

10 Q. When did you originate it, with relation to your applying for the patent?

A. Just before—some months before—and of course when I see I had it perfect I went and applied for it.

11 Q. What was the earliest date when this design was put on the market by you or any one else, so far as you know?

A. So far as I know, I was the first put it up.

21 12 Q. And when first?

A. About eighteen months, something like that; I can't remember exactly.

13 Q. How long before you obtained your patent for it?

A. I got it photographed when the guard was made in the shop.

14 Q. That is when you first made one of these designs in the shop?

A. Yes, and then applied for the patent.

15 Q. So you applied for letters patent immediately upon first manufacturing the guard?

A. Yes, sir.

16 Q. Do you know the defendants in this action, Smith & Brandell?

A. Yes, sir; I know Mr. Smith and I know Mr. Brandell.

17 Q. Did you sell any of these designs in any form of iron-work?

A. Yes, sir.

18 Q. What did you sell?

A. I sold window guards for four houses in One hundred and twentieth street.

19 Q. When was this?

A. About the time when I applied for the patent; I couldn't tell the date now.

20 Q. About January, 1888?

A. Somewheres around there.

21 Q. Did you sell these gates or guards similar to this to any one else between January and June, 1888?

A. No, sir.

22 Q. These houses in One hundred and twentieth street were the only ones you supplied?

A. Yes, sir.

23 Q. Upon those guards were there any marks?

A. Yes, sir; put on "patent applied for."

24 Q. Where was that mark stamped on the guard?

A. It is a plate put on the front of the window guard, on the frame.

25 Q. Describe as nearly as you can just how this was marked.

A. It was a plate of about two inches long and three-eighths wide.

26 Q. And where was that plate put on?

A. On the frame on the front of the window guard.

27 Q. And the letters were of what size which were stamped on this plate?

A. About the size of the plate, about three-eighths wide.

28 Q. Was that plate capable of being seen without removing any of the iron-work or the wood-work surrounding it?

Objected to.

22 A. It can be seen, of course.

29 Q. It is in open view?

A. Yes, sir; it is in front.

30 Q. To your knowledge, have the defendants, Messrs. Smith & Brandell, ever manufactured guards similar in design to the design in this suit?

A. Yes, sir.

32 Q. And sold them?

A. And sold them.

33 Q. To whom?

A. Squire & Whipple, builders.

34 Q. Were they erected in any houses?

A. Yes, sir.

35 Q. Where?

A. They were erected in Eighty-ninth street and West End avenue, New York.

36 Q. And how many, do you know?

A. Well, there were ten houses, I don't know exactly; about twenty, something like that.

37 Q. Have you a photograph of this work erected by the defendants on these houses of Squire & Whipple?

A. Yes, sir.

Defendants' counsel says that he will admit that the design made by the defendants is substantially similar.

38 Q. When, if you know, Mr. Pirkl, was this guard made according to this design so erected by the defendants; when was it put in the houses?

A. It was put up in the houses about last summer, about a year ago, I think, somewheres along there.

39 Q. Do you know at all exactly; do you know whether it was after May?

A. Yes, it was in the summer.

40 Q. You are sure it was after the first of May?

A. Oh, yes; I know it was later.

41 Q. Did you ever have any conversation with Messrs. Smith and Brandell about this design letters patent which is in suit?

A. Not exactly this patent, but about some other patent.

42 Q. These guards which the defendant put up similar in design to the design in this patent were not licensed by you?

A. No, sir.

23 43 Q. You never accepted any royalties for the manufacture of the same?

A. No, sir.

Mr. Keith reads cross-examination:

44 X Q. Mr. Pirkl, describe the plate which you have referred to upon this guard.

A. The plate is about two inches long and three-eighths of an inch wide.

45 X Q. Of what material?

A. Out of galvanized iron.

46 X Q. Is it screwed on?

A. It is riveted on; it is bent over on both sides and screwed on to the wood-work so that you can't get it off.

47 X Q. Are the guards painted—were these particular guards in One hundred and twentieth street painted?

A. They are painted now, I guess.

48 X Q. When were they painted first?

A. They were painted one coat in the shop, of course, then whatever the owner painted I don't know.

49 X Q. Was the plate painted also in the shop?

A. No, sir.

50 X Q. How do you know it was not?

A. Because I can tell you particularly, there was some of the men putting it up there, and the stone-cutters were there and said, "Hello, what is this here, is there a patent on it?" Says, "Very nice design," and so then my men told them there was a patent on this guard and they came back and told me that the owner was quite surprised and pleased with it.

51 X Q. When was this?

A. It was the time when they were putting it up.

52 X Q. The time they put up the guard or the plate?

A. The time they put up the guard; of course the plate was on before it went out of the shop.

53 X Q. Then, as a matter of fact the plate and the guard were painted in the shop together?

A. Not the plate but the guard was painted.

54 X Q. Was this work in One hundred and twentieth street done for Squire & Whipple?

A. No, sir; for Mr. Reed.

24 55 X Q. Have you ever had any dealings or any business with Squire & Whipple?

A. Yes, sir.

56 X Q. Did you make any estimate for them for guards in Eighty-ninth street and West End avenue?

A. Yes, sir.

57 X Q. Did you make any estimate on the guards which Smith & Brandell afterwards put up?

Objected to as immaterial.

A. I estimated on them.

58 X Q. At the time that you made that estimate did you know

that Squire & Whipple were getting estimates from other people for those guards?

Objected to as immaterial.

A. No, sir; not when I estimated.

59 X Q. When did you estimate it?

Objected to as immaterial.

A. I estimated somewheres around—it was in the winter I gave them an estimate on this guard, what he picked out in One hundred and twentieth street, that is where I gave him the estimate on it.

60 X Q. Did they make a proposal to you in writing?

Objected to as immaterial.

A. No, sir.

61 X Q. Did you give them a figure in writing?

Objected to as immaterial.

A. No, sir.

62 X Q. Then, it was verbal?

A. Yes, because I saw them very often, and they said they would like those guards the same way as One hundred and twentieth street, and I told them I put them up—I could make them.

63 X Q. Did you tell them these guards were patented?

A. No, sir.

25 64 X Q. Isn't it an advantage for you to conceal from the persons that you contract with that your design is patented?

Objected to as immaterial.

A. No.

65 X Q. Didn't you state to Mr. Smith substantially that it would be disadvantageous for you to have builders know that your guards were patented, because they were not likely to order patented designs on account of their price; didn't you say that to him?

Objected to as immaterial.

A. Yes, I did.

66 X Q. Didn't you know at the time that you made the estimate for Squire & Whipple that other parties were estimating on the window guards?

A. No, sir; I did not.

Mr. Olcott reads the redirect examination as follows:

68 R. D. Q. When you and Mr. Smith and Mr. Brandell were each applying for this job of Squire & Whipple's, and you bid upon it, did you seek to keep Smith & Brandell in ignorance of the fact that you had a patent upon this design?

A. No, sir; I did not; I didn't know they were figuring on that design.

Complainant's counsel offers in evidence a certified copy of the file-wrapper and contents in the matter of the design letters patent granted to John Pirkl May 1, 1888, No. 18293. Marked Complainant's Exhibit 1.

69 Q. Mr. Pirkl, you have testified that you sold window guards for four houses in One hundred and twentieth street designed after this patent No. 18293?

A. Yes, sir.

70 Q. And you said it was "about" in January, 1888; have you ascertained the exact date?

A. I couldn't tell you the exact date—December or January.

71 Q. Was it before the first of January, 1888?

A. I think it was about January—somewheres around Christmas time.

72 Q. Was it before the first of February 1888? Certainly?

A. Yes, sir; it was before that.

26 73 Q. Tell me what the photograph which you now produce, represents?

A. That photograph which you see, was taken from the corner of Eighty-ninth street and West End avenue.

74 Q. The work that you testified, Messrs. Smith & Brandell put up?

A. Yes, sir.

Photograph offered in evidence and marked Complainant's Exhibit 2.

Mr. Keith reads recross-examination as follows:

75 X Q. Did you make any window guards of this description before the ones which have been testified to?

A. No. sir.

76 X Q. Didn't you make some window guards for a house in Ninety-fifth street?

A. No, sir; not such guards as this.

77 X Q. What sort did you make?

A. I made other guards, but what I made in Ninety-fifth street there is no patent on.

78 X Q. How is that design different from the design in suit?

A. You will see right away when you look at it, that it is a different guard altogether. The difference is this way: they are raised out from the window and it gives the guard a different appearance altogether.

79 X Q. They stand out further from the window?

A. Yes, sir.

80 X Q. Is that the only difference between the guard that you speak of now and the other guards?

A. The only difference there is.

81 X Q. Then the only difference that you can specify between these window guards and the ones in Ninety-fifth street is, that the ones in One hundred and twentieth street were raised from the window, while these others were flat against the window?

Complainant's counsel objects to this question and the two questions before it, on the ground that the best evidence of similarity of design is the production of photographs; that Mr. Pirkl is not called here as an expert, and without the production of photographs should not be asked questions about them.

A. Yes, sir.

82 X Q. And there are no marks at all on those guards, are there, that would indicate there are any patents for them?

A. In Ninety-fifth street?

27 83 X Q. Yes, in Ninety-fifth street.

A. I think there is two different classes of guards in Ninety-fifth street.

84 X Q. I now refer to the window guards which are similar in design to the ones which have been testified to in One hundred and twentieth street, with the exception of the distance from which it is raised in reference to the window?

Complainant's counsel objects to the question on the ground that similarity of design is a matter either for expert testimony or to be decided as matter of law.

A. I understand that those are the ones that you refer to.

85 X Q. You claim to be the inventor of the design for window guards in the houses which have been testified about in One hundred and twentieth street, do you not?

A. Yes, sir.

86 X Q. You are fully acquainted with their design, are you?

A. Yes, sir.

87 X Q. So that there couldn't be any mistake when you say that these window guards are substantially the same, with the exceptions you have mentioned?

Complainant's counsel objects to the question as before.

A. Well, I don't make no mistake when I make the guard, that's sure enough.

88 X Q. Is that the best answer you can give?

A. I don't know what else I can answer.

89 X Q. How many window guards, of the design mentioned in your complaint, have you made in all?

A. Well, there were, at the corner of One hundred and twentieth street and Sixth avenue, for twelve houses, somewheres around one hundred, I guess; couldn't figure it just now of all that was made.

90 X Q. When Mr. Whipple, for whom you made this estimate, had the conversation with you in which he asked you to make a bid for this work on One hundred and twentieth street, what was his conversation with you as near as you can recollect now?

A. He had told me where he see these guards in One hundred and twentieth street—described the place. I said, "Yes, I made the guards;" he then said to give him a figure on it what they would cost.

91 X Q. And then you did give him a figure, did you?
A. Yes, sir.
92 X Q. Then, subsequent to that time, when did you learn first that Messrs. Smith & Brandell were making those guards for the job upon which you had estimated for Mr. Whipple?
A. That was about July, or might be later, in the following summer; July, 1888; somewheres around July or August, it was in the summer.
93 X Q. Now, didn't you go into the shop of Messrs. Squire and Whipple and have a conversation with them in reference to that same job, before they had actually furnished the work for the houses which you complained were furnished with guards by them?
A. No, sir, the only time that I talked with Squire & Whipple about the guards was when he said I lost the job.
94 X Q. Where did he say you lost the job?
A. It was in the office.
95 X Q. When was that?
A. It was about two or three months after I see them; couldn't tell now just exactly.
96 X Q. Did he give you any reason why you lost the job?
A. Yes, sir; he said Smith & Brandell were about five hundred dollars lower.
97 X Q. Did you have any conversation with Smith & Brandell in relation to that same work before they furnished these window guards?
A. Yes, sir.
98 X Q. What did you say to them?
A. I told them that Smith & Brandell beat me five hundred dollars on the job.
99 X Q. You told Smith & Brandell that they had beaten you five hundred dollars on the job?
A. Yes.
100 X Q. How many of these window guards had you put up, Mr. Pirkl, before you took out your *your* letters patent?
A. Put none of them up.
101 X Q. None of them except what you have testified to?
A. That was the first one. Put a plate on with "patent applied for" before I got my patent.
102 X Q. You testified the other day about the marks on
29 those guards, did you ever take those marks off?
A. No, sir.
103 X Q. Never?
A. No, sir.
104 X Q. Haven't they ever been changed?
A. The guards?
105 X Q. The marks.
A. No, sir.
106 X Q. So that the words are still there as they stood when they were first put on?
A. Yes, sir; so far as I know.

107 X Q. What are those words?

A. "Patent applied for."

108 X Q. Have any other words or any other marks been placed on those window guards by you since they were erected?

A. No, sir.

109 X Q. Have you made any similar guards to the ones you have testified to since May, 1888?

A. Yes; made them for Squire & Whipple.

110 X Q. Are those all marked?

A. Yes, sir.

111 X Q. How are they marked?

A. With the plate, in the same way.

Mr. Olcott reads redirect examination:

112 Q. When were these guards, which you testified that you put up in Ninety-fifth street, which are more or less similar to the design in this suit, erected by you?

A. Been up about three years.

113 Q. Not more than three years ago?

A. Not more; less than three years ago—around three years ago.

114 Q. Less than three years ago?

A. Yes, sir.

115 Q. How much have you charged on the average a square foot on guards of this design?

A. Seventy-five cents a square foot.

116 Q. How many square feet are there in the guards of this design which you have testified to were manufactured by Smith & Brandell?

A. Somewheres around eight hundred square feet.

117 Q. You have made a calculation to find out the number of square feet, and, as near as you can come to it, that is the figure?

A. Yes, sir; may be less or more.

30 118 Q. At that time which you have just testified to, when you saw Squire & Whipple and were told by them that your bid was rejected for this Eighty-ninth street work, did you know that the successful bidders, Smith & Brandell, were going to use your design?

Objected to.

A. No, sir.

119 Q. At the time that you have last testified to, when you saw Smith & Brandell and told them that they had beat you by five hundred dollars, did you know that they were going to use your design?

Objected to as leading.

A. No, sir.

120 Q. Did you know, as a matter of fact, that they were using your design at any time before the guards were actually erected by Smith & Brandell?

A. No, sir.

121 Q. What was the figure that you bid to Squire & Whipple for those guards, do you remember?

Objected to as immaterial.

A. Seventy-five cents a square foot.

122 Q. What was the entire figure, do you remember?

A. The entire figure was over $1,200, but there was gates and rear guards at the end; the figuring up is seventy-five cents a square foot.

Mr. Keith reads recross-examination:

123 X Q. You have been engaged in the iron business for quite a long time, have you not?

A. Yes.

124 X Q. How long?

A. Do you mean the time I have been in business for myself?

125 X Q. All together.

A. About thirty years.

126 X Q. And how long have you been in business for yourself?

A. In business for myself a little over four years.

127 X Q. You have had occasion to make a good many estimates for contractors and architects?

A. Yes, sir.

31 128 X Q. Quite extensively?

A. Yes, sir.

129 X Q. You have competed a good deal, have you not, with other iron people for contracts, made competitive estimates with them?

A. I suppose so; of course I don't know.

130 X Q. In a competitive bid for work, isn't it usual for competitors to bid on the same thing?

A. If there is a drawing made and specifications by the architect it is, but if not, it is not.

131 X Q. How many gates or guards with your patented design have you put into public use since the date of your patent?

A. About a hundred, I guess; somewhere along about that; I couldn't just count them up now; might be fifty or sixty; might be a hundred or more; I couldn't tell exactly.

132 X Q. Where are they?

A. Some in Eighty-sixth street and West End avenue.

133 X Q. How many are there?

A. I think there were eleven houses there.

134 X Q. With how many guards each?

A. Some about five on the corner, some one or two; one house on the corner had six or seven.

135 X Q. In each of those houses?

A. Some two and some only got one.

137 X Q. How many have two?

Complainant's counsel objects to all questions as to the number of guards used in the different houses as immaterial.

138 X Q. Didn't you estimate on these guards?
A. Certainly I did.
139 X Q. Then, can't you remember any nearer than some two and some one?
A. Not nearer than that.
140 X Q. What other houses have you put these guards on since the first of May, 1888?

Objected to as immaterial.

A. One hundred and twentieth street and Sixth avenue—twelve houses.
141 X Q. That is the one in suit?
A. No, sir; between One hundred and twentieth and One
32 hundred and twenty-first street and Sixth avenue, east side—twelve houses.
142 X Q. Can you think of any other houses that have these guards since May 1, 1888?

Objected to as immaterial.

A. I don't know exactly now, how many guards or where they are, but if you wish to know I will count them up and see where they are.
143 X Q. That is all you can tell at present?
A. Yes, sir.
144 X Q. Have all these guards at Eighty-sixth street and One hundred and twentieth street marks similar to those you have described?
A. Yes, sir; exactly.

Mr. Olcott reads redirect examination:

145 Q. That is to say, all these guards are marked "Patent applied for," or "Patented"?
A. The ones in One hundred and twentieth street and Sixth avenue were.
146 Q. Now, as to the ones in Eighty-sixth street, what were they marked?
A. "Patented May 1, 1888." I know there is a plate, that is certain.
147 Q. In the case of this Squire & Whipple bid for guards at Eighty-ninth street, which Smith & Brandell got in competition with you, were there any drawings or specifications of these guards made or furnished you?
A. No, sir.
148 Q. And were you told by Squire & Whipple that they were getting competitive estimates against you on the same design?
A. No, sir; I expected to be alone.

Mr. Keith reads recross-examination:

149 X Q. And after you did make this estimate and before the guards had been erected by Smith & Brandell, you told them

33 that they had succeeded in getting the job because they were several hundred dollars lower in their bid than you?

A. Yes, sir.

Mr. Olcott reads redirect examination:

150 Q. And at that last-spoken-of interview with Smith & Brandell, you did not know that they were making guards from this design?

A. No, sir.

(It is agreed that the order for the guards in Eighty-ninth street given by Squire & Whipple to Smith & Brandell was given in March, 1888, and the work delivered and erected in July, 1888.)

(Complainant rests.)

Defendants offer to consent to an injunction restraining them from manufacturing guards similar in design to the one complained of, and to pay the costs of this action up to date, upon its discontinuance, without further proceedings.

Mr. Keith reads the direct examination of ANDREW L. SMITH, a witness called on behalf of the defendant-, as follows:

1 Q. You are one of the defendants in this action?

A. Yes, sir.

2 Q. What is your business?

A. Wire and iron railing manufacturers.

3 Q. You have heard the testimony of the complainant, have you?

A. I have.

4 Q. You manufactured the window guards in Eighty-ninth street, did you?

A. Yes.

5 Q. How many were there?

A. There was something like twenty.

6 Q. At the time you received the order for those guards did you know that any patent had been applied for by Mr. Pirkl for them, or by any one else?

A. No, I did not.

34 7 Q. When did you first learn that such was the case?

A. When I got a letter from Mr. Pirkl's lawyer.

8 Q. When was that?

A. After we put the guards up.

9 Q. What date?

A. July, 1888.

10 Q. Have you made any other guard similar in design to those for any other persons?

A. No, sir.

11 Q. Before or since?

A. No, sir.

Mr. Olcott reads cross-examination:

12 Q. Mr. Smith, did the letter which you have testified as having

received from Mr. Pirkl's lawyer offer to release you from any liability for this infringement upon the payment of a royalty of so much a square foot?

Objected to. This letter should be produced in evidence.

A. Yes; I believe so.

13 Q. Have you that letter with you?

A. No; I have not.

14 Q. Did you after receiving that letter which you have testified to call upon Mr. Pirkl's attorney?

A. Yes.

15 Q. Was there any conversation had between you as to what terms of settlement Mr. Pirkl would accept?

A. No, I don't think there was.

16 Q. Do you remember what was said by Mr. Pirkl's attorney to you at that interview?

A. I remember that I said he had no case against us, that I accepted that order before the patent was granted on it or I knew there was any patent applied for, and he was also in our place, and knew that we had that order, and it was always customary for us to figure on the same work, and I thought it was out of the question to ask any royalty or anything else.

17 Q. Then there was a royalty asked for, was there?

A. In your letter, yes.

18 Q. Well, what?

A. You asked for thirty-five cents a square foot on the work.

Defendants' counsel objects to the question as immaterial.

19 Q. Did you refuse to pay that royalty?

Objected to as immaterial.

A. I did.

Cause argued and submitted.

35 At a stated term of the circuit court of the United States of America for the eastern district of New York, in the second circuit, held at the United States court building, on the 13th day of May, 1890.

Present: The Honorable Hoyt H. Wheeler, district judge, holding the court by assignment.

JOHN PIRKL
vs.
ANDREW L. SMITH and HENRY BRANDELL. } In Equity.

This cause came on to be heard at the March, 1890, term, and was argued by counsel; and thereupon, upon consideration thereof, it is ordered, adjudged, and decreed as follows, viz.:

That the design letters patent No. 18293, granted and issued on the first day of May, 1888, to John Pirkl, being the letters
36 patent referred to in the bill of complaint herein, are good and valid in law.

That the said John Pirkl was the first and original inventor and discoverer of the design for gates and window guards, as described and claimed in the said letters patent and the specification annexed thereto, and is the exclusive owner of said patent.

That the defendants herein have infringed upon the said letters patent and upon the exclusive rights of the complainant under the same—that is to say, by making and selling one or more window guards of the design secured to the complainant by the above-mentioned patent, as charged in the bill of complaint herein.

And it is further ordered, adjudged, and decreed that the said complainant, John Pirkl, do recover of the said defendants,
37 Andrew L. Smith and Henry Brandell, the sum of two hundred and fifty dollars ($250), the measure of the profits, gains, and advantages, as fixed by statute, which the said defendants have received or made or which have arisen or accrued to them from their said infringement.

And it is further ordered, adjudged, and decreed that the said complainant do recover of the said defendants his costs, charges, and disbursements in this suit, taxed at one hundred nine and $\frac{17}{100}$ dollars.

And it is also further ordered, adjudged, and decreed that a perpetual injunction be issued in this suit against the said defendants, restraining them and each of them, their and each of their agents, clerks, servants, and all claiming or holding under or through them or either of them, from making, selling, or using or in
38 any manner disposing of any article embracing the invention or design or improvement described in the said letters patent, pursuant to the prayer of said bill of complaint.

HOYT H. WHEELER.

Endorsed: Decree. Filed May 13, 1890.

39 United States Circuit Court, Eastern District of New York.

JOHN PIRKL, Complainant and Appellee,
vs.
ANDREW L. SMITH & HENRY BRANDELL, Defendants & Appellants.

To the honorable the Supreme Court of the United States:

The appeal of Andrew L. Smith and Henry Brandell, the above-named defendants and appellants, respectfully showeth—

That upon the ninth day of July, 1889, the above-named complainant filed his bill in the circuit court of the United States for the eastern district of New York against the above-named defendants and appellants, Andrew L. Smith and Henry Brandell,
40 to enjoin and restrain the said defendants and appellants from an alleged infringement of certain letters patent granted to the said complainant for a certain ornamental design applicable to window guards, which design letters patent were numbered 18293 and dated May 1st, 1888, and praying an account of profits from

said alleged infringement and an assessment of damages arising therefrom, and praying that the said defendants pay over to the said complainant the sum of two hundred and fifty dollars, and in case the total profits made by them from such alleged infringement should exceed the sum of two hundred and fifty dollars, that said defendants should be compelled to pay to the said complainant, in addition to the said sum of two hundred and fifty dollars, all
41 profits in excess of said sum; that a subpœna issued out of the said circuit court of the United States in and for the eastern district of New York, and was duly served on the defendants and appellants, Andrew L. Smith and Henry Brandell; that the said defendants and appellants filed their answer to said bill of complaint, to which the complain-t and appellee filed a general replication.

That such proceedings were had in the cause that on or about the 13th day of May, 1890, a final decree was entered therein enjoining and restraining the defendants and appellants, Andrew L. Smith and Henry Brandell, from making, selling, or using the said design described in said letters patent and decreeing judgment against them for two hundred and fifty dollars, together with costs, &c., and final judgment was entered the 14th day of May, 1890, as will appear by said judgment and record.

42 And the defendants and appellants, Andrew L. Smith and Henry Brandell, feeling aggrieved thereby, hereby appeal from said decree and final judgment to the Supreme Court of the United States, and they pray that said appeal may be allowed, and that a transcript of the records, pleadings, proceedings, and evidence in the cause, fully authenticated, may be sent to the Supreme Court of the United States without delay, and that the said Supreme Court of the United States may proceed to hear the cause anew, and that the said decree may be reversed and such other decree made as to the said Supreme Court of the United States shall seem just.

Dated May 22, 1890.

LEAVITT & KEITH,
Solicitors for Defendants and Appellants.

BOUDINOT KEITH, *Counsel.*

43 Bond approved and appeal allowed May 26, 1890.

HOYT H. WHEELER, *Judge.*

Endorsed: Petition of appeal. Filed May 27, 1890.

44 U. S. Circuit Court, Eastern District of N. Y.

JOHN PIRKL
vs.
ANDREW L. SMITH and HENRY BRANDELL.

Bond for Damages and Costs.

Know all men by these presents that we, Lawrence Ryan, of No. 223 Twenty-sixth street, Brooklyn, N. Y., and William McQuade, of

No. 17 Fulton street, Brooklyn, N. Y., are held and firmly bound unto the above-named John Pirkl, of the city of Brooklyn, in the sum of one thousand dollars, to be paid to the said John Pirkl; for the payment of which, well and truly to be made, we bind ourselves and each of us, our and each of our heirs, executors, and administrators, jointly and severally, firmly by these presents.

45 Sealed with our seals and dated the twenty-fourth day of May, in the year of our Lord one thousand eight hundred and ninety.

Whereas the above-named Andrew L. Smith and Henry Brandell have prosecuted an appeal to the Supreme Court of the United States to reverse the decree rendered in the above-entitled suit by the judge of the circuit court of the United States for the eastern district of New York:

Now, therefore, the condition of this obligation is such that if the above-named Andrew L. Smith and Henry Brandell shall prosecute their said appeal to effect and answer all damages and costs if they shall fail to make their plea good, then this obligation shall be void; otherwise the same shall be and remain in full force and virtue.

46 LAWRENCE RYAN. [L. S.]
WM. McQUADE. [L. S.]

Sealed and delivered and taken and acknowledged this 24th day of May, 1890, before me—

B. LINCOLN BENEDICT,
U. S. Commissioner.

I hereby consent to the form of the above bond and the sufficiency of the sureties thereon.

Dated May 24th, 1890.

W. M. K. OLCOTT,
Proctor for Complainant.

Approved May 26, 1890.

HOYT H. WHEELER, *Judge.*

Endorsed: Bond for damages and costs. Filed May 27, 1890.

47 UNITED STATES OF AMERICA, } ss:
Eastern District of New York, }

I, B. Lincoln Benedict, clerk of the circuit court of the United States of America for the eastern district of New York, in the second judicial circuit, do hereby certify that the foregoing pages, numbered from one to forty-six, inclusive, contain a true and complete transcript of the record and proceedings had in this court in the case of John Pirkl, complainant, *vs.* Andrew L. Smith and Henry Brandell, defendants, as the same remains of record and on file in this court.

In testimony whereof I have caused the seal of said court to be hereunto affixed, at the city of Brooklyn, in the eastern district of New York, this 15th day of September, in the year of our Lord one thousand eight hundred and ninety, and of the Independence of the United States the one hundred and fifteen.

The Seal of the Circuit Court, Eastern District of New York.

B. LINCOLN BENEDICT, *Clerk.*

48 U. S. Supreme Court.

ANDREW L. SMITH & HENRY BRANDELL, Pl'ffs in Error,
against
JOHN PIRKL, Def't in Error.

It is hereby stipulated that the record on appeal from the circuit court of the U. S. for the eastern district of New York, as prepared & made up by the clerk of said circuit court, is correct and shall stand as the record of this case on said appeal.

Dated New York, Sept. 11th, 1890.

LEAVITT & KEITH,
Att'ys for Pl'ffs in Error.
W. M. K. OLCOTT,
Att'y for Def't in Error.

48½ [Endorsed:] U. S. Supreme Court. Andrew L. Smith & Henry Brandell, plaintiffs in error, ag'st John Pirkl, defendant in error. Stipulation as to record. Leavitt & Keith, attorneys for plaintiffs in error, 111 Broadway, New York city.

49 United States Circuit Court, Eastern District of New York.

JOHN PIRKL
vs.
ANDREW L. SMITH and HENRY BRANDELL. } In Equity. April Term, 1890.

This suit is brought upon design patent No. 18293, dated May 1, 1888, issued to the orator for a window guard. The defendants admit that window guards of this design were ordered of them in March, 1888, and delivered by them in July, 1888, but deny that they knew of the patent before the delivery, and such knowledge is not shown.

A statute provides that, for any person other than the owner of a patent for a design, without license, to apply the design or any colorable imitation thereof "to any article of manufacture
50 for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied," shall during the term of the patent be unlawful; and that any person violating these provisions or either of them "shall be liable in the amount of two hundred and fifty dollars," and for the excess of profit above that

amount, "the full amount of such liability" to be recovered "by action at law or upon a bill in equity for an injunction to restrain such infringement." 24 Stat., 387, chap. 105. Whether the defendants applied the design to the guards before or not till after May 1, 1888, is not shown, and, as argued in their behalf, they may not have so applied it within the term of the patent, which
51 begun on that day, and cannot be held liable under this statute for that; but the sale of the guards was completed when they were delivered, which was in July, 1888, and clearly within the term of the patent. They knew that the design had been applied to the guards which they so sold, for they applied it; and they knew it was so applied without license, for they had no license, and must have known that. That they did not know of the patent is urged against liability on account of the sale; but the statute does not include knowledge of the patent among the things necessary to create this liability; it only requires that the design shall have been applied without license and a sale, "knowing that it has been so applied." The defendants—unwittingly, perhaps—appear to have brought themselves clearly within this branch of the statute.

52 The orator has shown no measure of profits due to the design alone, and asks for no profits beyond the $250 given by the statute. Counsel for the defendants argues that this is a penalty or forfeiture which cannot be recovered in this form. That the profits could be recovered in this form without the statute is not questioned. The statute seems to give this amount as a measure of profits in cases where a less amount only can be proved, and not as a penalty above the actual profits. The profits as such, whether fixed in amount by statute or by finding, would be recoverable in the same manner in either case. Newman *vs.* Waite, 43 Vt., 587; same case under name of Waite *vs.* Dowley, 94 U. S., 527. The statute itself removes all doubt about this by expressly providing for the
53 recovery of the full amount of the liability upon a bill in equity for an injunction to restrain the infringement. This is such a bill. The statute seems to be intended to carry out the idea that the amount of the liability is merely a fixed measure of profits which may be decreed in equity as an incident to the jurisdiction for relief by injunction in the same behalf. Root *vs.* Railway Co., 105 U. S., 189. As the orator claims no profits beyond the $250 given by the law, there is no question about the amount and no occasion to send the case to a master. A decree for the orator for that amount of profits as an incident to a decree for an injunction appears to be required by that statute, as the case stands.

Counsel for the defendants further insists that the cross-examination of the orator shows an abandonment of the substantial part of this design to the public, and he asks leave to amend the
54 answer and make this defence, if that evidence will bear it out; but this testimony shows rather a preference of one style of guards of this design to another than any purpose to abandon the design itself. It would fall far short of making out this defence if set up.

Let a decree be entered for an injunction and $250 profits, with costs.

HOYT H. WHEELER.

W. M. K. Olcott, for orator; Boudinot Keith, for defendants.

Endorsed: Decision. Filed April 21, 1890.

55 UNITED STATES OF AMERICA, *ss:*

To John Pirkl, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington on the second Monday of October, eighteen hundred and ninety, pursuant to a writ of error filed in the clerk's office of the circuit court of the United States for the eastern district of New York, wherein Andrew L. Smith and Henry Brandell are plaintiffs in error and you are defendant in error, to show cause, if any there be, why the judgment in the said writ of error mentioned should not be corrected and speedy justice should not be done to the parties on that behalf.

Dated May 29th, 1890.

HOYT H. WHEELER, *Judge.*

56 [Endorsed:] U. S. Supreme Court. Andrew L. Smith & Henry Brandell, plaintiffs in error, against John Pirkl, defendant in error. Citation. Leavitt & Keith, attorneys for plaintiffs in error, 111 Broadway, New York city. Due service of a copy of the within citation is hereby admitted this 10 day of July, 1890. W. M. K. Olcott, attorney for defendant in error.

Endorsed on cover: Case No. 14,180. E. New York C. C. U. S. No. 200. Andrew L. Smith and Henry Brandell, appellants, *vs.* John Pirkl. Filed September 27, 1890.